

Application No.: 10/658,337
Amendment dated October 17, 2005
Reply to Office Action of June 15, 2005

Amendments to the Drawings

Please replace drawing Figure 6 with the attached proposed amended informal Figure 3. A formal version of Figure 6 will be submitted promptly via a Supplemental Response.

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Remarks

The Applicant respectfully requests entry of the above Amendment, and consideration of the application as amended.

By this Amendment, the Applicant cancelled claims 12, 13, and 26 and introduced new claims 36-38. Claims 36 and 37 correspond to cancelled claims 12 and 13. Claim 18 was amended to clarify the wording of a limitation of the claim and claims 30 and 31 were amended to provide proper dependency. No new matter was introduced.

Claims 1, 16 -25, and 27-38 are now pending in this application.

1. Response to Election/Restrictions

In paragraph 1 on page 2 of the Action, the Patent Office withdrew claim 26 from further consideration as being drawn to a non-elected species. In response, the Applicant has cancelled claim 26.

2. Information Disclosure Statement

In paragraph 2 on page 2 of the Action, the Patent Office states that a copy of reference AA was not included with the IDS filed on April 25, 2005. Though the Applicant is confident that reference AA was submitted earlier, a copy of the as-filed IDS and a copy of reference AA are included with this letter.

3. Response to Amendment

In paragraph 3 on page 2 of the Action, the Patent Office advises the Applicant that claim 12 and 13 were previously canceled. The Applicant acknowledges with appreciation the Patent Office's assistance in this matter, since the file history is somewhat ambiguous. By the above amendment, the Applicant reintroduced the subject matter of claims 12 and 13 as new claims 36 and 37.

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4. Drawings

In paragraph 4 on page 3 of the Action, the Patent Office advises the Applicant that drawings submitted on July 25, 2005 were approved, but then in paragraph 5 on page 3, the Patent Office objected to Figure 6. In a phone conversation with Examiner Darren Ark on July 5, 2005, the Applicant's undersigned Agent was advised that the aperture at the end of the embodiment shown in Figure 6 is not identified. This objection would be addressed by simply labeling the aperture and including appropriate amendments to the specification. In the above amendment, the Applicant makes a bona fide effort to address these objections. In addition, the specification was amended to clarify the description of the embodiment shown in Figure 6. No new matter was introduced. The Applicant acknowledges with appreciation Examiner Ark's assistance with addressing this objection.

5. Response to Rejections Pursuant to 35 USC §112

In paragraphs 6 through 9 on page 4 of the Action, the Patent Office rejects claims 1, 16, 17, and 29-35 under 35 U.S.C. 112, first and second paragraphs, for failing to enable and for being indefinite. The Patent Office states that these rejections are based on the claimed location of the hook with respect to the "first aperture 40" and the "second aperture 60" identified in and discussed with respect to Figure 6. Though the Applicant believes that this objection is inappropriate, that is, any aperture can be a "first" or a "second" aperture, the Applicant believes that the above amendments to Figure 6 and to the specification address these rejections. The Applicant respectfully requests that these rejections be withdrawn.

6. Response to Rejections Pursuant to 35 USC §102 and Ehlers

In paragraphs 10 and 11 on page 5 of the Office Action, the Patent Office rejected claims 1, 16, 32, 33, and 35 pursuant to 35 U.S.C. 102(b) as anticipated by U.S. Patent 4,898,431 of Ehlers [herein "Ehlers"]. However, the Applicant respectfully

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submits that this rejection is inappropriate and respectfully requests that the Patent Office reconsider this rejection in view of the following observations and comments.

As noted in the comments submitted on April 25, 2005, the Applicant's undersigned Agent often refers to the MPEP for assistance when considering whether an anticipation rejection is appropriate. Specifically, MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate, which appear in the earlier comments but are not repeated here. With respect to the rejection of claim 1, the Applicant submits that Ehlers does not set forth each and every element set forth in claim 1 and does not disclose the identical invention shown in as complete detail as recited in claim 1. Thus, the Applicant respectfully submits that Ehlers does not anticipate the invention of claim 1.

Specifically, the Patent Office identifies fishing lure 10 of Figures 1-4 of Ehlers as anticipating present claim 1. The Applicant submits that the fishing lure 10 of Ehlers lacks at least the following elements and features of the claimed invention:

- a) The hook of Ehlers is not mounted between the first and second aperture;
- b) The hook of Ehlers is not attached by a molded material; and
- c) Ehlers does not disclose spurs extending from the back portion and front portion.

First, the hook of Ehlers is not attached between the first and second apertures as claimed. The Patent Office has identified holes 11, 24 of Ehlers as the first aperture and the hole "through which [rivet] 58 extends" as the second aperture. However, the hook 50 of Ehlers is not attached between these two apertures. Since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

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Second, contrary to the invention recited in claim 1, the hook of Ehlers is not attached by molded material. Specifically, body 12 of Ehlers clearly does not attach hook 50 to the lip. As stated by Ehlers in column 3, lines 27-29: "Body 12 is formed of a soft, pliable plastic material which yields under the force of a bite, or strike, of a fish." [Emphasis added.] Having this molded material yield when it is most needed, that is, during a strike, clearly indicates that Ehler's hook is not "attached to the lip" by this molded material as in the claimed invention. Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

Finally, Ehlers does not disclose spurs extending from the back portion and front portion. In the Office Action, the Patent Office identifies the barbs 40 and 42 of hook 50 of Ehlers as the claimed spurs. However, in the claimed invention, the spurs are "provided between the back portion and the front portion of the lip," for example, as shown at 75 in Figure 6. The Applicant respectfully submits that the barbs 40 and 42 of Ehlers are not positioned between the front and back portions of Ehlers lure, but extending out the back of Ehlers' lure. Moreover, the claimed invention clearly recites "a hook" and "a plurality of spurs," that is, two distinct features. The Patent Office has cited the same element of Ehlers for two different elements in the claimed invention. Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

The Applicant submits that any one of these distinctions is sufficient to overcome an anticipation rejection of claim 1 based upon Ehlers. However, the existence of at least these three (3) distinctions underscores how markedly different the device of Ehlers is from the invention recited in claim 1.

With respect to the rejection of claim 16, 32, 33, and 35 as anticipated by Ehlers, the Applicant submits that these claims are not anticipated by Ehlers for the same

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reasons claim 1 is not anticipated by Ehlers. The Applicant respectfully requests that these rejections also be reconsidered and withdrawn.

7. Response to Rejections Pursuant to 35 USC §102 and Marshall

In paragraph 12 bridging pages 5 and 6 of the Office Action, the Patent Office rejected claims 18-25 and 27-31 pursuant to 35 U.S.C. 102(b) as anticipated by U.S. Patent 5,077,931 of Marshall [herein “Marshall”]. However, the Applicant respectfully submits that this rejection is inappropriate and respectfully requests that the Patent Office reconsider this rejection in view of the following observations and comments.

As described throughout the specification, one aspect of the invention provides “an environmentally friendly alternative to lead split shot, sinkers, and lead jigs.” (page 4, lines 3-5). As stated in the line bridging pages 7 and 8 of the specification, “Like all of the embodiments of the metal lip jig rig, the metal lip 20...is used in lieu of a lead sinkers and lead jigs.” [Emphasis added.] That is, as claimed in claim 18, one aspect of the invention comprises a “non-toxic fishing sinker.” The Applicant respectfully submits that the devices disclosed by Marshall are not sinkers, but lures. Therefore, Marshall does not anticipate the invention recited in claim 18.

The devices in Marshall cited by the Patent Office are lures. As described at 5:45-46 of Marshall, “[T]he fishing lure 11 of FIGS. 7 and 8 is characterized by an upward bend...” [Emphasis added.] Nowhere in Marshall do the inventors disclose or suggest that the lure 11 is a sinker. In fact, the Applicant submits that Marshall actually teaches away from the use of lure 11 as a sinker. Though limited description of lure 11 is provided by Marshall, at 3:31-33, the inventors describe related lure 12 shown in Figures 1-3 as “Preferably the spoon blade 12 is of lightweight variety designed to ride up over very heavy cover [that is, weeds].” [Emphasis added.] Clearly a lightweight device designed to ride “up over” weeds is not intended to be a sinker as claimed. The Applicant requests that this rejection be reconsidered and withdrawn.

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Moreover, the Marshall lure does not include parallel lateral sides. Though the Patent Office incorrectly identified the top and bottom surfaces of the Marshall lure 11 as the claimed parallel sides, the Applicant believes that the amended wording of claim 18 clearly identifies the lateral sides of the elongated neck portion as being substantially parallel. This feature is also not found in the Marshall lure 11, which has sides that taper or are non-parallel. Thus, based also on this limitation of claim 18, it is not anticipated by Marshall.

With respect to dependent claims 19-25 and 27-31, these claims are not anticipated by Marshall for the same reason that claim 18 is not anticipated by Marshall. However, certain dependent claims include limitations that are not anticipated by Marshall. With respect to claim 22, contrary to the statements made by the Patent Office, the “weedguard 50” of Marshall are not spurs, as understood from the instant specification, but simply wires. Though not described with respect to Figures 7 and 8, Marshall’s weedguard 50 is described at 4:20:22 as “wire-like member[s],” not spurs. Moreover, claim 31 recites that the claimed spurs “are adapted to retain one of a second hook and bait.” As clearly implied by their use as a bait holder, the claimed spurs comprise at least some rigidity that is not found or suggested by the wire weedguard of Marshall. The Applicant submits that the wire-like weedguard of Marshall is clearly not adapted to retain a second hook or bait. The Applicant requests that these rejections be reconsidered and withdrawn.

8. Response to Rejections Pursuant to 35 USC §103 in view of Marshall and Brott

In paragraph 16 on pages 7 and 8 of the Office Action, the Patent Office rejected claims 1, 17, 17, 29-32, 34, and 35 pursuant to 35 U.S.C. 103(a) as obvious in view of the combined teachings of Marshall and U.S. Patent 5,216,830 of Brott [herein “Brott”]. However, the Applicant respectfully submits that this rejection is inappropriate and respectfully requests that the Patent Office reconsider this rejection in view of the following observations and comments.

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First, as discussed above and contrary to the statement made by the Patent Office, the wire-like weedguard 50 of Marshall does not comprise spurs as disclosed in this application. Second, the Marshall does not include a "punched out strap" or any structure that has the structure of the claimed punched out strap as described and shown in the instant specification.

Third, it is well established that there must be some suggestion or motivation in the references to combine their teachings. For example, the MPEP under 2143 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added.]

The Applicant submits that there is no suggestion or motivation to combine the teachings of Marshall and Brott.

The Patent Office admits that Marshall does not teach that the hook be attached to the lip by molded material. The Patent Office relies on the teachings of Brott to provide the teachings missing in Marshall. Specifically, the Patent Office states that it would be obvious to combine the molded lead of Brott. However, the Applicant submits that, as discussed above and throughout this proceeding, one objective of the present invention is to provide an environmentally friendly non-lead fishing device. With that goal in mind, the teachings of Brott would not be helpful and would be avoided by one of skill in the art.

Moreover, Marshall clearly teaches away from the use of the teachings of Brott. First, Marshall already attaches the hook 30 by means of screw 40. Why then would

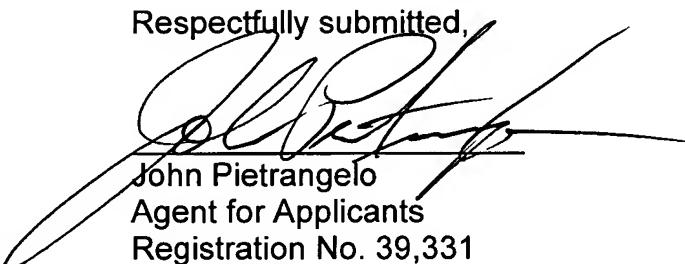
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Marshall need to a molded lead body to attach its hook? Furthermore, as discussed above, Marshall intends to provide a "lightweight lure," that is, one "designed to ride up over very heavy cover." The use of the heavy lead molding of Brott clearly interferes with that goal. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

7. Conclusions

The Applicant believes that the application is in allowable form. Early passage of the application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action.

Respectfully submitted,



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